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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,256	07/15/2001	Hidekazu Tanaka	AA374F	7253

27752 7590 07/03/2002

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/868,256

Applicant(s)

TANAKA ET AL.

Examiner

Gina C. Yu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachm nt(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on April 8, 2002. Claims 1, 2, and 4-10 are pending. Claim rejections under 35 U.S.C. 112 are maintained in part as indicated in the previous office action dated November 8, 2001. Claim rejections under 35 U.S.C. 103 are withdrawn and new rejections are made in view of the claim amendment made by applicants.

Specification

The application contains a terminology which is so different from that which is generally accepted in patent procedure. The specification states that the term "comprising" in claims encompass "consisting of" and "essentially consisting of". See spec. 3, lines 1-3. Applicant's terminology is unacceptable because the terms "comprising", "consisting of", and "essentially consisting of" are different transitional phrases used to define the scope of a claim, and may not be used in place of one another. See MPEP § 2111.03.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161

F.2d 367, 73 USPQ 482 (CCPA 1947). The term “comprising” in claims 1, 7, 8, and 10 are used by the claim to encompass “consisting of” and “essentially consisting of”. See spec. 3, lines 1-3.

Applicant's state in response filed on April 8, 2002, that the term “comprising” is used as a traditionally recognized term. While the term itself is a well-recognized term in patent law, applicants' usage of the term in this case is not in accordance with the usual meaning of that term. Manual of Patent Examining Procedure § 2111.03 states that the scope of the claims is defined by the transitional phrases. Applicants in this case, however, designated the term to encompass the terms consisting of and consisting essentially of. See spec. 3, lines 1-3. In view of the disclosure therein, the term “comprising” used in the present application is unacceptable.

The term “ratio” in claims 2, 4, and 5 is vague because it is not clear whether the measurement is in weight or volume. Claim 8 is vague because it is not clear whether the percentage of the components is in weight, volume, or moles.

Applicants in response note that the disclosure in specification which states, “[A]ll percentages, ratios, and levels of ingredients referred to herein are based on the actually total amount of the composition”. Examiner views that this disclosure alone does not support whether the recited ratio or percentages are defined by the weight, volume, or moles in the total composition.

Claim 4 recites the limitation “polyoxyethylene (POE) castor oil ester” in claim 2, which refers to claim 1. There is insufficient antecedent basis for this limitation in the claim.

Applicants assert that the surfactants in claim 4 are found in claim 1. Examiner notes that claim 1, while reciting POE "castor oil" and POE "hydrogenated castor oil ester", does not recite POE castor oil ester.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sumida in view of Derwent Acc. No. 1991-202615 (abstract of JP 2799600 B2, assigned to Kobayashi Kose) ("Kobayashi abstract" hereunder).

Sumida teaches transparent microemulsion composition comprising (a) 0.1-30.0wt % of nonionic surfactants which include polyoxyethylene castor oil or hardened castor oil derivatives; (b) 0.001-20 wt % of ionic surfactants which include polyoxyethylene alkyl ether phosphate; (c) 0.1-30wt % of oil; and (d) 40-99 wt % of water. See Translation, p. 2 – p. 6. Polyoxyethylene sorbitol tetraoleate is disclosed on p. 5, group 10. Example 1 on p. 8 shows the use of polyhydric alcohol. The types of oil and additives which may be used for the invention are also discussed. The reference further teaches that the preferred ratio of nonionic surfactant to oily substance is 1: 1-3, which meets instant claim 2. It teaches that at a high ratio of surfactant to oil the skin safety and feel are degraded. See p. 3, last paragraph. The reference further teaches that the preferred ratio of ionic surfactant to oil is 1:0.01-2.0. See p. 6, paragraph 3. Although the specific ratio of each surfactants are not disclosed in the reference,

examiner views that given the teachings of the preferred surfactants and their amounts in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.

While Sumida teaches that the disclosed ionic surfactants are used alone or in combination of two or more, the reference fails to provide particular motivation to select polyoxyethylene sorbit tetraalkyl ester.

Kobayashi abstract teaches a transparent cosmetic composition comprising polyoxyethylene sorbitol tetraoleic acid ester. The reference teaches that the material has "excellent storage stability and non-greasy feeling on use", as well as emollient and moisturizing effect. See Use.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the formulations in Sumida by adding polyoxyethylene sorbitol tetraoleate as motivated by Kobayashi because of the expectation of successfully producing a transparent cosmetic composition which provide long shelf-life as well as non-greasy feel and moisturizing effect on skin.

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayanagi et al. (U.S. Pat. No. 5474776) ("Kayanagi").

Kayanagi teaches transparent cosmetic composition comprising (a) hydrophilic nonionic surfactants which may include the surfactants of instant claim 8 (a); (b) liquid oil; (c) water-soluble compound which may include polyhydric alcohol; (d) water. See abstract; col. 2, line 23 – col. 6, line 27. The reference mentions polyoxyethylene sorbitan fatty acid ester and polyoxyethylene hardened castor oils are particularly

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preferred, and may teaches that the surfactants may be used singly or in combination, meeting instant claim 1. See col. 3, lines 33 – 37. Instant claim 6 is met by the disclosure of the types of oil used in the invention in col. 4, lines 50 – 67. See instant claim 9. The additives are disclosed in col. 6, lines 2 – 12, meeting instant claim 10. The reference further teaches that (a) 1-30 wt % of surfactants (b) 1-60 wt % of liquid oil; (c) 10-70 wt % of water-soluble compound; and (d) 1-87.99 wt % of water. See instant claim 8.

Response to Arguments

Applicant's arguments filed April 8, 2002 have been fully considered but they are moot in view of new ground of rejection in part, and not persuasive in part.

Applicants' argument regarding the obviousness rejection in view of Sumida is rendered moot in view of new ground of rejection. Examiner notes however that applicants' remarks in reference to the method of making the emulsion is irrelevant in this case since the instant claims are directed to compositions.

Applicants assert that there is no teaching in Kayanagi to use tetra alkyl esters with any of the recited surfactants of the instant claims. Examiner respectfully disagrees, as the reference in col. 3, lines 38 – 43 does state that the disclosed nonionic surfactants "may be used either singly or in any combination thereof."

Examiner also finds it unpersuasive that a skilled artisan would unlikely choose the nonionic surfactants claimed by applicants from the disclosure of Kayanagi because the prior art is a cleansing formula whereas the instant invention is a leave-on

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composition. This argument is not commensurate with the scope of the claims, which is not limited to any specific type of cosmetic composition.

All ingredients and general condition of the claimed invention are well known in cosmetic art. Nothing unexpected or nonobvious is seen in combining conventional ingredients used in cosmetic micro-emulsion formulations. See MPEP 718.02.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 24, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
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